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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TOUFIC BOUBEZ, STEPHEN L. BURBECK, JAMES B. CASLER, STEPHEN G. GRAHAM, and MARYANN HONDO

Appeal 2009-006740
Application 09/758,112
Technology Center 3600

Before MURRIEL E. CRAWFORD, ANTON W. FETTING, and BIBHU R. MOHANTY, *Administrative Patent Judges*.

CRAWFORD, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134 (2002) from a Final Rejection of claims 1-31. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

Appellants invented online systems and methods for categorizing services using canonical service descriptions (Spec. 1:21-22).

Independent claim 1 under appeal reads as follows:

> 1. A method, in a data processing system, of registering services in a taxonomy, comprising:
> receiving a registration request at the data processing system, the registration request including a service description and an identification of a category within the taxonomy in which the service is to be registered;
> determining if the service description should be registered in the identified category based on a canonical service description associated with the category; and
> registering the service description in the identified category using the data processing system if the determination is that the service description should be registered in the identified category.[1]

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Poon	US 2002/0062265 A1	May 23, 2002

[1] The claims set forth in the Claims Appendix of the Replacement Appeal Brief filed July 13, 2007 do not appear to include the changes made to the claims in the Amendment filed March 28, 2005. As that Amendment was entered and considered by the Examiner in the Office Action mailed June 28, 2005, we refer to those claims set forth in the Amendment in deciding this appeal.

The Examiner rejected claims 1-31 under 35 U.S.C. § 102(e) as being unpatentable over Poon.

ISSUES

Did the Examiner err in asserting that the subject matter of independent claims 11 and 21 is anticipated by Poon?

Did the Examiner err in asserting that the subject matter of independent claims 1 and 31 is anticipated by Poon?

Did the Examiner err in asserting that the subject matter of dependent claims 2-10 is anticipated by Poon?

FINDINGS OF FACT

Poon

The client browser 336 within the client application 332 receives category hierarchy data from the server application 312 at step 405. The category hierarchy data includes category and subcategory information. Using the category data, the client browser 336 performs the category selection process as follows. Once the user is ready to select an item category, at step 410, a decision is made whether a category number is available to the user. If the user has previously selected the same category and subcategories and has stored the category number associated with the category and the respective subcategories, the user enters the category number at step 420. As a result, based on the category number, the respective category and related subcategories are selected and displayed by the client browser 336 in the respective fields ([0028]).

If the category number or numeric I.D. is not available, then, at step 430, the user selects a category from a list of available categories displayed in an interactive category area. Next, the client browser 336 performs a test whether the selected category has related subcategories at step 440. If the selected category has no related subcategories, then the user has the option to record the category number of the selected category at step 445 and may proceed further with the item registration process ([0029]).

ANALYSIS

Independent Claims 11 and 21

We are persuaded that the Examiner erred in asserting that Poon anticipates the subject matter of independent claims 11 and 21 (App. Br. 12-14). Poon discloses that the user performs the recited determining step by navigating various categories and subcategories prior to selecting the one most appropriate for the good/service they wish to register. Once the user has selected an appropriate category/subcategory, the user submits the registration request with a description of the good/service and the category/subcategory ([0028]-[0029]).

Independent claim 11 recites first, second, and third instructions of a computer program product on a computer readable medium as performing the aforementioned steps. Poon does not recite any such instructions, computer program product, or computer readable medium for performing at least the second instruction which includes the determining step, as the user in Poon performs this step.

Independent claim 21 recites means for performing the receiving, determining, and registering steps. Page 7 of the Appeal Brief recites a

combination of broker 420, device 104, data processing system 200, processors 202, 204, and memory 209 as means for performing the aforementioned steps. Poon recites that the user performs at least the determining step.

Accordingly, as this is a rejection under § 102(e), we will not sustain this rejection.

Independent Claims 1 and 31

We are not persuaded that the Examiner erred in asserting that Poon anticipates the subject matter of independent claims 1 and 31 (App. Br. 12-14). Unlike independent claims 11 and 21, independent claims 1 and 31 are method claims. Accordingly, Poon's disclosure of the user performing the "determining" step is sufficient to anticipate the recited aspects.

Moreover, Poon discloses that once the number of possible subcategories has been exhausted, the user has the option to record the category number of the selected category for the particular auction item with web server 310 at step 445 ([0029]). This corresponds to the "receiving" and "registering" steps recited in independent claims 1 and 31.

Dependent Claims 2-10

We are persuaded that the Examiner erred in asserting that Poon anticipates the subject matter of some of dependent claims 2-10 (App. Br. 12-14). For claim 2, Poon discloses a "canonical service description identif[ying] minimum criteria for the category," as Poon's category, at a minimum, includes a title which corresponds to "minimum criteria." *See In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004)

(during examination of a patent application, a pending claim is given the broadest reasonable construction consistent with the specification and should be read in light of the specification as it would be interpreted by one of ordinary skill in the art).

For claim 3, Poon's recordation of the particular auction item in web server 310 with a selected category corresponds to the recited "storing the service description and an associated model description in a storage in association with the category."

For claims 5 and 6, we agree with Appellants. Poon does not disclose requesting to add a new category. All queries to server application 312 merely bring up existing categories.

For claim 7, we agree with Appellants that Poon does not disclose security requirements, privacy requirements, and communications protocol requirements. However, because such requirements are nothing more than printed matter, we use our authority under 37 C.F.R. § 41.50(b) (2009), and enter a new ground of rejection for this claim under 35 U.S.C. § 103(a) as being obvious over Poon. *See In re Gulack*, 703 F.2d 1381, 1385-86 (Fed Cir. 1983) (where the printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability).

For claim 8, the user in Poon performs the recited steps of searching for and registering the auction item under alternate categories.

For claims 4, 9, and 10, Appellants only argue that they depend from allowable independent claim 1. Accordingly, we sustain the rejections of those claims.

DECISION

The decision of the Examiner to reject claims 1-4, 8-10, and 31 is affirmed.

The decision of the Examiner to reject claims 5, 6, and 11-30 is reversed.

Using our authority under 37 C.F.R. § 41.50(b), we newly reject claim 7 under 35 U.S.C. § 103(a) as being obvious over Poon.

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)). 37 C.F.R. § 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 C.F.R. § 41.50(b) also provides that the appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

> (1) *Reopen prosecution*. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner . . . .
>
> (2) *Request rehearing*. Request that the proceeding be reheard under § 41.52 by the Board upon the same record . . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED-IN-PART; 37 C.F.R. § 41.50(b)

hh

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